


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number Q76655	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	Filed	
	10/623,568	July 22, 2003	
	First Named Inventor		
	Daisuke SUZUKI		
	Art Unit	Examiner	
	2629	Seokyun MOON	
WASHINGTON OFFICE 23373 CUSTOMER NUMBER			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>55,154</u></p> <p> Signature</p> <p><u>David P. Emery</u> Typed or printed name</p> <p><u>(202) 293-7060</u> Telephone number</p> <p><u>April 28, 2008</u> Date</p>			

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q76655

Daisuke SUZUKI, et al.

Appln. No.: 10/623,568

Group Art Unit: 2629

Confirmation No.: 6560

Examiner: Seokyun MOON

Filed: July 22, 2003

For: INPUTTING DEVICE AND MOBILE TERMINAL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Further to the Examiner's Final Office Action dated December 27, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal. As April 27, 2008, fell on a Sunday the present filing is timely.

Applicant turns now to the rejections at issue:

Claim Rejections - 35 U.S.C. § 102(b)

Claim 1 is rejected under § 102(b) as being anticipated by Ikehara (US 6,400,353). Applicants traverse this rejection as follows.

Claim 1 recites, *inter alia*, a sliding key that is fixed on the outside surface of said elastic sheet with at least a portion in said opening of said cabinet surface.

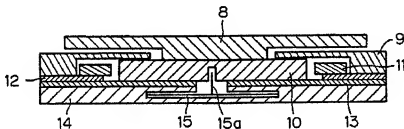
Applicants submit Ikehara fails to disclose or even fairly suggest this feature.

In the rejection, the Examiner alleges Ikehara's coupling pin 15a is part of the sliding key. As a basis for this position, the Examiner alleges: (1) the coupling pin is moveable in a horizontal direction; and (2) the courts have held that integrating a plurality of separated parts

into a single part is generally recognized as being within the level or ordinary skill in the art. (*Office Action*, pp. 2-3; citing *Larson*, 144 USPQ 347, 349 (CCPA 1965). However, Applicants respectfully disagree because: (1) whether or not the coupling pin 15a is horizontally movable is not relevant to whether it is part of the sliding key; and (2) *Larson* fails to support the Examiner's position. ***Foremost, however, the coupling pin 15a is merely a bent portion of elastic member 15.***

The Examiner seems to contend that because the horizontal pin 15a is horizontally movable, it is part of the sliding key. However, with reference to FIG. 3 reproduced below,

FIG.3



Ikehara clearly discloses that the operation electrode 10 and the coupling pin 15a are detached. While pin 15a may contact the operation electrode 10 when the operating portion 8 is moved to the left or right, there is no support in Ikehara that these portions are attached. Thus, Applicants submit coupling pin 15a is not part of the sliding key.

However, the Examiner alleges the coupling pin 15a is part of the operation electrode 10 because it may move horizontally. Regarding this point, Applicants submit the Examiner's contention that two separate pieces may move in the same direction fails to provide a basis for the Examiner's allegation that they are part of the same piece.

Further, the Examiner attempts to compensate for this deficiency by citing *Larson*, contending it would be obvious to make separate parts a single part. As an initial point, Applicants note that because this is an anticipation rejection under 35 U.S.C. § 102(b), the use and reliance on an alleged obvious modification is improper. But Applicants also note that

Larson fails to support the Examiner's position. Specifically, in Larson, the court held that a claim reciting "a brake drum integral with said clamping means" was not patentable over Tuttle et al. (US 2,974,970), which disclosed brake discs provided on a sleeve attached to a casing clamp. (*Larson*, 144 USPQ at 349.). These components were rigidly secured together. The premise of the courts holding was that the term "integral" did not distinguish over Tuttle, which showed a disc rigidly secured to the clamping means. Thus, the court held that a one piece construction would be an obvious design choice over a structure composed of constituent parts rigidly secured together. (*Id.*). In this way, Larson only stands for the proposition that if parts are already rigidly secured it is an obvious design choice to make them into a one piece construction.

Because Ikehara discloses a distinct separation between coupling pin 15a and the operation electrode 10, even under an obviousness rejection, Larson would fail to support the Examiner's purported modification of making integral, separate parts. Rather, Larson *only supports making integral, parts that are disclosed as being rigidly secured*. Therefore, Applicants submit that because coupling pin 15a is not a part of Ikehara's operation electrode 10 and operating portion 8, Ikehara fails to disclose that operation electrode 10 and operating portion 8 are fixed to elastic member 15.

Essentially, the Examiner takes the position "since the coupling pin is involved in the sliding movement of the operation electrode 10 and, without the coupling pin 15a, the operation electrode would not function as a sliding key, it would be reasonable to refer a combination of the operation electrode 10 and the coupling pin 15a as a sliding key." (*Advisory Action*, p. 2).

However, Applicants submit the Examiner's position is unreasonable. Clearly, as depicted in FIG. 3 below, the operating portion 8 and operation electrode 10 would function with or without the coupling pin 15a. This coupling pin 15a is merely an extension of the elastic member 15 and functions to engage with the operation electrode 10 so that the operation electrode 10 is "returned to the center position if the user release[s] his or her hands." (col. 5, lines 42 - 50). While the coupling pin 15a aids in returning the operation electrode 10 to the center position, the Examiner's position that "without the coupling pin 15a, the operation electrode would not function as a sliding key," is wholly without merit.

In conclusion, Applicants submit Ikehara fails to disclose an elastic sheet or a sliding key fixed to an elastic sheet for the reasons set forth above.

Thus, Applicants submit claim 1 is allowable for at least those reasons set forth above.

Claim Rejection - 35 U.S.C. § 103(a)

Claim 12/1, 19/1 and 21/1 stand rejected under §103(a) as being unpatentable over Ikehara.

In response to this rejection, Applicants submit that because the Examiner's purported modifications of Ikehara in view of alleged obvious design choices fail to compensate for the above noted deficiencies of Ikehara as applied to claim 1 above, claims 12/1, 19/1 and 21/1 are submitted to be allowable, at least by virtue of their dependencies.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 9/1, 10/9/1, 18/1, 20/1, 22, 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 stand rejected under § 103(a) as being unpatentable over Ikehara in view of Takatsuka (US 2004/0080491).

In response to this rejection, Applicants submit that because Takatsuka, either taken alone or in combination with Ikehara, fails to compensate for the above noted deficiencies of Ikehara as applied to claim 1, claims 9/1, 10/9/1, 18/1 and 20/1 are allowable, at least by virtue of their dependency.

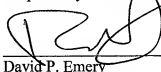
Regarding independent claim 22, the Examiner references Ikehara as disclosing the recited "elastic sheet having an outside surface disposed in an inside surface of said cabinet" and "a sliding key that is fixed on the outside surface of said elastic sheet." More specifically, the Examiner cross references the application of Ikehara to claim 1 (as described above) to support this position. However, Applicants submit that Ikehara fails to disclose these features for the same reasons set forth above with regard to claim 1. Moreover, Applicants submit that because Takatsuka, either taken alone or in combination with Ikehara, fails to compensate for these deficiencies of Ikehara, claim 22 is allowable because the Takatsuka / Ikehara combination fails to disclose either the "elastic sheet having an outside surface disposed in an inside surface of said

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cabinet” or the “sliding key that is fixed on the outside surface of said elastic sheet,” as recited in claim 22. Furthermore, Applicants submit claims 24, 27, 29, 40/22, 41/40/22, 43/22 and 45/22-49/22 are allowable, at least by virtue of their dependency.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David P. Emery', is written over a horizontal line.

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